

4077 DIV-REISSUE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Reissue Patent Application of :  
 Mark H. Sanders :  
 Serial No. (To be assigned) : Examiner (to be assigned)  
 Filed (To be assigned) : Group (to be assigned)  
 For Reissue of Patent 5,343,878 :  
 Issued September 6, 1994 :  
 For Pressure Application Method :

Pittsburgh, Pennsylvania

Jul 22, 1996

REISSUE APPLICATION DECLARATION AND

POWER OF ATTORNEY BY INVENTOR

Hon. Commissioner of Patents  
 and Trademarks

Washington, D. C. 20231

Sir:

I, Mark H. Sanders, hereby declare that:

1. I am a citizen of United States of America and a resident of Wexford, Pennsylvania, that my residence and post office address is as indicated below next to my signature, that I believe I am the original, first and sole inventor of the subject matter described and claimed in U. S. Patent 5,343,878 and in the foregoing specification, and for which invention I hereby solicit a reissue patent.

2. I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by the accompanying Preliminary Amendment.

3. I acknowledge the duty to disclose information which is material to the examination of this application in accordance with 37 CFR 1.56.

4. I believe patent 5,343,878 to be partly inoperative because of error which occurred without any deceptive intention, by reason of my having claimed less than I had a right to claim, and by reason of the U.S. Patent & Trademark Office having erroneously identified the inventive entity on the face of the patent.

5. Specifically, claims 1 to 3 of patent 5,343,878 are directed to a method of treating sleep apnea syndrome, and recite, inter alia, applying to frontal portions of a patient's neck a pressure sufficiently less than ambient pressure to distend adjacent neck tissue in a manner effective for alleviating obstruction of the patient's airway in sleep. Directing the claims to treatment of sleep apnea syndrome improperly limits the claims in that the pertinent disclosure in the patent is not limited to treatment of sleep apnea syndrome. Likewise, the recital of pressure less than ambient pressure to distend neck tissue improperly limits the claims because pressure less than ambient pressure was merely my preferred modality for applying an impetus to distend the patient's neck tissue.

6. On reviewing the specification of patent 5,343,878 it is clear to me that I broadly disclosed, at column 9, lines 28 to 36 for example, a method of treatment, not limited to sleep apnea syndrome treatment, which includes

applying to frontal portions of a patient's neck an impetus which distends adjacent neck tissue. Thus, through error I claimed less than I had a right to claim in the patent.

7. As to the further error in identification of the inventorship on the face of patent 5,343,878, I am sole inventor of the invention claimed in the patent, the additional named inventors Scarberry and Handke having been erroneously included on the face of the patent.

8. The prosecution of patent 5,343,878 was conducted by the assignee of record, Respironics Inc., through the agent of record, J. Stewart Brams. I therefore have no personal knowledge of how the above specified errors occurred or were discovered; however, I have read the supporting declarations of Eugene N. Scarberry and J. Stewart Brams, copies of which are attached hereto as Attachment A, and I believe they accurately set forth the circumstances of how the specified errors occurred and were discovered.

9. Until so advised by a letter from J. Stewart Brams dated June 21, 1996, and during a meeting with Mr. Brams on July 2, 1996, I did not know or appreciate that the application disclosed, and that I could claim, a method for treating sleep apnea syndrome, or more generally a method for treating an upper airway disorder, which included applying to frontal portions of a patient's neck an impetus supplied by a suitable modality to distend adjacent neck tissue in a manner effective for alleviating obstruction of the patient's airway in sleep. I now understand that limitation of the patent claims to treatment of sleep apnea syndrome, and to the specific modality of pressure less than ambient pressure to provide the distending impetus resulted in the

patent claiming less than I had a right to claim.

10. I hereby appoint J. Stewart Brams, Registration No. 27,858, or his duly appointed associates, my agent with full power of substitution, revocation and addition, to prosecute this application and transact all business with the U.S. Patent & Trademark Office in connection therewith; and I request that all correspondence be directed to J. Stewart Brams at 300 Mt. Lebanon Boulevard, Suite 204, Pittsburgh, PA 15234.

WHEREFORE, I pray that a reissue patent be granted for the invention or discovery described and claimed in the foregoing specification and claims and I hereby subscribe my name to the foregoing specification and claims, Declaration, Power of Attorney, and this Petition.

The undersigned Petitioner declares further that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made, are punishable by fine, or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of this application or of any patent issuing thereon.

Date: 8/19/96

243 Ash Court  
Wexford, PA 15090

Mark H. Sanders  
Mark H. Sanders

## ATTACHMENT A

1. The first step in the process is to identify the problem or issue that needs to be addressed. This involves gathering information and understanding the context of the situation.

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DECLARATION OF J. STEWART BRAMS

Hon. Commissioner of Patents  
and Trademarks

Washington, D. C. 20231

Sir:

I, J. Stewart Brams, hereby declare that:

1. I am a patent agent duly registered to practice before the United States Patent and Trademark Office under Registration No. 27,858.
2. I am making this Declaration in support of inventor Mark H. Sanders' application for reissue of U.S. patent 5,343,878.
3. I filed U. S. Patent Application Serial No. 69,739 on June 1, 1993, and prosecuted said application to issuance as Patent No. 5,343,878 on September 6, 1994. The prosecution of said application was conducted by the

assignee of record, Respironics Inc.

4. I am familiar with patent 5,343,878, including the claims thereof. In particular, I am aware that the claims of said patent are directed to a method of treating sleep apnea syndrome, and include the limitation of applying a pressure less than ambient pressure to frontal portions of a patient's neck to distend adjacent neck tissue in a manner effective for alleviating obstruction of a patient's airway in sleep. I believe these limitations constitute error in patent 5,343,878 in that the inventor claimed less than he had a right to claim. The said error occurred and was discovered as follows.

5. During the prosecution of patent 5,343,878, I did not understand or appreciate that, based on the invention as disclosed in the application, the inventor could claim a method for treating sleep apnea syndrome, or more generally a method for treating an upper airway disorder, which included, inter alia, applying to frontal portions of a patient's neck an impetus for distending adjacent neck tissue in a manner effective for alleviating obstruction of the patient's airway in sleep. I further did not appreciate that the requisite impetus could be supplied by any suitable modality not limited to pressure less than ambient pressure, and that pressure less than ambient was merely the inventor's preferred modality for supplying the requisite impetus to distend the patient's neck tissue.

6. Subsequent to July 14, 1995, Eugene N. Scarberry, an employee of the assignee, Respironics Inc., telephoned me to discuss patent 5,343,878. Mr. Scarberry related to me a suggestion by one Kingman Strohl that a spring biased apparatus, similar in concept to an enlarged Breathe Right (tm) brand

nasal strip, could be adhesively affixed to frontal portions of a patient's neck to draw outward or distend adjacent neck tissue for the purpose of alleviating obstruction of a patient's airway in sleep. Mr. Scarberry inquired as to whether patent 5,343,878 claimed or could claim this or other alternative modalities for distending a patient's neck tissue to alleviate airway obstruction. Prior to this discussion with Mr. Scarberry, I was unaware of the possibility of any such alternative modalities for applying the requisite impetus to frontal portions of a patient's neck, in accordance with the claims of patent 5,343,878.

7. On or about November 10, 1995, I undertook a review of my file of patent 5,343,878 and advised Mr. Scarberry that the patent broadly discloses, and that it appeared the inventor could claim, a method including, inter alia, applying an impetus to frontal portions of a patient's neck to distend adjacent neck tissue. During this review of my patent 5,343,878 file, I discovered a further error in said patent in that the inventive entity is misidentified on the face of the patent. I believe this further error occurred as a result of the U.S. Patent & Trademark Office having incorrectly construed papers no. 7 and 8, entered by the applicant and the examiner, respectively, during the prosecution of the patent, which papers deleted the names of inventors Scarberry and Handke, and correctly set forth that Mark H. Sanders was the sole inventor of the allowed claims.

8. Subsequent to May 21, 1996, Mr. Scarberry asked me to proceed with preparation of the proposed reissue application.



9. In conjunction with my subsequent preparation of the reissue patent application for patent 5,343,878, I concluded that the claims of the patent contained further error in that they are limited to a method of treating sleep apnea syndrome even though the pertinent disclosure in the patent is not limited to treatment of sleep apnea syndrome.

10. I advised inventor Mark H. Sanders by letter on June 21, 1996, and during a meeting with him on July 2, 1996, that the errors characterized above had been discovered in his patent 5,343,878, and that the assignee, Respironics Inc., had proposed filing of a reissue application to correct these errors.

11. I declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under Section 1001 of Title 18 of the United States Code and that such willful false statements made jeopardize the validity of the application or patent issuing thereon.

Date \_\_\_\_\_

\_\_\_\_\_  
J. Stewart Brams

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Pittsburgh, Pennsylvania

Jul 22, 1996

DECLARATION OF EUGENE N. SCARBERRY

Hon. Commissioner of Patents  
and Trademarks

Washington, D. C. 20231

Sir:

I, Eugene N. Scarberry, hereby declare that:

1. I am an employee of Respironics Inc., the assignee of record in U.S. Patent 5,343,878.

2. I am making this Declaration in support of inventor Mark H. Sanders' application for reissue of patent 5,343,878.

3. I am familiar with patent 5,343,878, including the claims thereof. In particular, I am aware that all of the claims of said patent include the limitation of applying a pressure less than ambient pressure to frontal

portions of a patient's neck to distend adjacent neck tissue in a manner effective for alleviating obstruction of a patient's airway in sleep. I believe this limitation constitutes an error in patent 5,343,878 in that the inventor claimed less than he had a right to claim. The said error was discovered as follows.

4. On or about July 14, 1995, I became aware that Kingman Strohl, who is a medical consultant to Respironics Inc., had suggested the possibility that a spring biased apparatus, similar in concept to an enlarged Breathe Right (tm) brand nasal strip, could be adhesively affixed to frontal portions of a patient's neck to draw outward or distend adjacent neck tissue for the purpose of alleviating obstruction of a patient's airway in sleep.

5. Subsequently, I related Kingman Strohl's suggestion to J. Stewart Brams, the agent of record in patent 5,343,878, and inquired of Mr. Brams as to whether the patent claimed or could claim this or other alternative modalities for drawing out or distending neck tissue in a patient's neck to alleviate airway obstruction in sleep. Mr. Brams subsequently advised me that the patent does broadly disclose, and that it appeared the inventor could claim, a method including, inter alia, applying an impetus to frontal portions of a patient's neck to distend adjacent neck tissue, and that a reissue application could be filed to assert this broadened claim.

6. On May 21, 1996, I attended a meeting of the Respironics Inc. Patent Committee and related to the Committee my discussions with Mr. Brams concerning reissue of patent 5,343,878. The Committee discussed prospects for reissuing patent 5,343,878, and authorized filing of the reissue patent

application to which this declaration pertains. I then notified Mr. Brams to proceed with preparation of the proposed reissue application.

7. I declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application, or any patent issuing thereon.

Date:

7/29/96

*Eugene N. Scarberry*

Eugene N. Scarberry

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DECLARATION OF J. STEWART BRAMS

Hon. Commissioner of Patents  
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Washington, D. C. 20231

Sir:

I, J. Stewart Brams, hereby declare that:

1. I am a patent agent duly registered to practice before the United States Patent and Trademark Office under Registration No. 27,858.
2. I am making this Declaration in support of inventor Mark H. Sanders' application for reissue of U.S. patent 5,343,878.
3. I filed U. S. Patent Application Serial No. 69,739 on June 1, 1993, and prosecuted said application to issuance as Patent No. 5,343,878 on September 6, 1994. The prosecution of said application was conducted by the

assignee of record, Respiroics Inc.

4. I am familiar with patent 5,343,878, including the claims thereof. In particular, I am aware that the claims of said patent are directed to a method of treating sleep apnea syndrome, and include the limitation of applying a pressure less than ambient pressure to frontal portions of a patient's neck to distend adjacent neck tissue in a manner effective for alleviating obstruction of a patient's airway in sleep. I believe these limitations constitute error in patent 5,343,878 in that the inventor claimed less than he had a right to claim. The said error occurred and was discovered as follows.

5. During the prosecution of patent 5,343,878, I did not understand or appreciate that, based on the invention as disclosed in the application, the inventor could claim a method for treating sleep apnea syndrome, or more generally a method for treating an upper airway disorder, which included, inter alia, applying to frontal portions of a patient's neck an impetus for distending adjacent neck tissue in a manner effective for alleviating obstruction of the patient's airway in sleep. I further did not appreciate that the requisite impetus could be supplied by any suitable modality not limited to pressure less than ambient pressure, and that pressure less than ambient was merely the inventor's preferred modality for supplying the requisite impetus to distend the patient's neck tissue.

6. Subsequent to July 14, 1995, Eugene N. Scarberry, an employee of the assignee, Respiroics Inc., telephoned me to discuss patent 5,343,878. Mr. Scarberry related to me a suggestion by one Kingman Strohl that a spring biased apparatus, similar in concept to an enlarged Breathe Right (tm) brand

nasal strip, could be adhesively affixed to frontal portions of a patient's neck to draw outward or distend adjacent neck tissue for the purpose of alleviating obstruction of a patient's airway in sleep. Mr. Scarberry inquired as to whether patent 5,343,878 claimed or could claim this or other alternative modalities for distending a patient's neck tissue to alleviate airway obstruction. Prior to this discussion with Mr. Scarberry, I was unaware of the possibility of any such alternative modalities for applying the requisite impetus to frontal portions of a patient's neck, in accordance with the claims of patent 5,343,878.

7. On or about November 10, 1995, I undertook a review of my file of patent 5,343,878 and advised Mr. Scarberry that the patent broadly discloses, and that it appeared the inventor could claim, a method including, inter alia, applying an impetus to frontal portions of a patient's neck to distend adjacent neck tissue. During this review of my patent 5,343,878 file, I discovered a further error in said patent in that the inventive entity is misidentified on the face of the patent. I believe this further error occurred as a result of the U.S. Patent & Trademark Office having incorrectly construed papers no. 7 and 8, entered by the applicant and the examiner, respectively, during the prosecution of the patent, which papers deleted the names of inventors Scarberry and Handke, and correctly set forth that Mark H. Sanders was the sole inventor of the allowed claims.

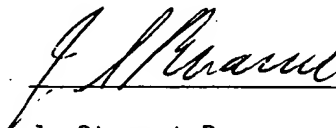
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10. I advised inventor Mark H. Sanders by letter on June 21, 1996, and during a meeting with him on July 2, 1996, that the errors characterized above had been discovered in his patent 5,343,878, and that the assignee, Respironics Inc., had proposed filing of a reissue application to correct these errors.

11. I declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under Section 1001 of Title 18 of the United States Code and that such willful false statements made jeopardize the validity of the application or patent issuing thereon.

Date 8-22-96

  
J. Stewart Brams